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The paragraph beginning on page 8, line 22, has been amended as follows:

A tension retainer is disposed on shaft 60. In a preferred embodiment, the tension retainer includes a coned disk spring 73, alternatively known as a spring washer, accompanied by a flat washer 75. Disk spring 73 is disposed on threaded portion 62 of shaft 60 such that a cup 77 of disk spring 73 points toward second clamp member 56. Flat ~~wash~~ washer 75 is subsequently disposed on shaft 60 between disk spring 73 and second clamp member 56.

REMARKS

In the parent (10/093,243) to the present 37 CFR 1.53(b) Continuation application, an Office Action dated 30 July 2003 rejected claims 1-6, 13, and 27-32. In addition, the Office Action objected to claims 7-12, 14-17, and 33-38 as being dependent upon rejected base claims and allowed claims 18-26 and 39-43. Claims 1-6, 13, and 27-32 were canceled and claims 7, 9, 10, 12, 14, 17, 33, 35, 36, and 38 were amended in the 15 September 2003 Amendment in the parent application. Claims 8, 11, 15, 16, 34, and 38 remained unchanged as originally filed in the parent application.

Claims 1-6, 13, and 27-32 from the parent application have been renumbered and amended herein when compared to the parent application. In addition, new claims 3, 5, 7, 10, 16, and 19 have been added in this Continuation application.

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Claim 1 of the 37 CFR 1.53(b) Continuation application, formerly claim 27 in the parent application, remains unchanged as originally filed in a 14 April 2003 Preliminary Amendment in the parent case.

Claim 2 of the 37 CFR 1.53(b) Continuation application, formerly claim 28 in the parent application, has been amended to correct the dependency of claim 2. Accordingly, claim 2 depends from claim 1 in the Continuation application.

Claim 3 of the 37 CFR 1.53(b) Continuation application is a new claim.

Claim 4 of the 37 CFR 1.53(b) Continuation application, formerly claim 29 in the parent application, has been amended to correct the dependency of claim 4. Accordingly, claim 4 depends from claim 1 in the Continuation application.

Claim 5 of the 37 CFR 1.53(b) Continuation application is a new claim.

Claim 6 of the 37 CFR 1.53(b) Continuation application, formerly claim 30 in the parent application, has been amended to correct the dependency of claim 6. Accordingly, claim 6 depends from claim 1 in the Continuation application.

Claim 7 of the 37 CFR 1.53(b) Continuation application is a new claim.

Claim 8 of the 37 CFR 1.53(b) Continuation application, formerly claim 31 in the parent application, has been amended to

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correct the dependency of claim 8. Accordingly, claim 8 depends from claim 1 in the Continuation application.

Claim 9 of the 37 CFR 1.53(b) Continuation application, formerly claim 32 in the parent application, has been amended to correct the dependency of claim 9. Accordingly, claim 9 depends from claim 8 in the Continuation application.

Claim 10 of the 37 CFR 1.53(b) Continuation application is a new claim.

Claim 11 of the 37 CFR 1.53(b) Continuation application, formerly claim 13 in the parent application, remains unchanged as originally filed in the parent case.

Claim 12 of the 37 CFR 1.53(b) Continuation application, formerly claim 1 in the parent application, remains unchanged as originally filed in the parent case.

Claim 13 of the 37 CFR 1.53(b) Continuation application, formerly claim 2 in the parent application, has been amended to correct the dependency of claim 13. Accordingly, claim 13 depends from claim 12 in the Continuation application.

Claim 14 of the 37 CFR 1.53(b) Continuation application, formerly claim 3 in the parent application, has been amended to correct the dependency of claim 14. Accordingly, claim 14 depends from claim 12 in the Continuation application.

Claim 15 of the 37 CFR 1.53(b) Continuation application, formerly claim 4 in the parent application, has been amended to

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correct the dependency of claim 15. Accordingly, claim 15 depends from claim 12 in the Continuation application.

Claim 16 of the 37 CFR 1.53(b) Continuation application is a new claim.

Claim 17 of the 37 CFR 1.53(b) Continuation application, formerly claim 5 in the parent application, has been amended to correct the dependency of claim 17. Accordingly, claim 17 depends from claim 12 in the Continuation application.

Claim 18 of the 37 CFR 1.53(b) Continuation application, formerly claim 6 in the parent application, has been amended to correct the dependency of claim 18. Accordingly, claim 18 depends from claim 12 in the Continuation application.

Claim 19 of the 37 CFR 1.53(b) Continuation application is a new claim.

The Office Action in the parent case rejected claims 1-4 and 27-30 under 35 U.S.C. §102(b) as being anticipated by *Mathieu* (U.S. Patent No. 4,167,646). The Office Action in the parent case further rejected claims 5, 6, 13, 31, and 32 under 35 U.S.C. §103(a) as being unpatentable over *Mathieu*. *Mathieu* teaches of a vibration damper that includes a damper housing (14) and a damper cap (16) which is pivotally attached thereto. The *Mathieu* vibration damper further includes two damper elements (36, 38) supporting rigid absorber arms (44, 46). Vibration damping weights 70, 78) are attached to respective absorber arms (44, 46).

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Regarding claim 1 of the 37 CFR 1.53(b) Continuation application, the Office Action in the parent case indicates that *Mathieu* teaches the invention of claim 1 (formerly claim 27 in the parent application). In particular, the Office Action indicates that *Mathieu* teaches of an alleged claim limitation of "said first and second extension sections continuously abutting said second clamp member to prevent rotation of said second clamp member about said fastener." The Office Action cites Fig. 2 of the *Mathieu* reference as an alleged teaching of Applicants' claimed invention.

Claim 1 (formerly claim 27) fails to include the limitation of "said first and second extension sections continuously abutting said second clamp member to prevent rotation." Rather, claim 1 (formerly claim 27) recites "one of said first and second clamp members including an extension section" and "said extension section preventing rotation of said second clamp member about said fastener." Accordingly, claim 1 (formerly claim 27) should be examined in light of the actual language presented in the claim.

Fig. 2 and the corresponding text at col. 3, lines 22-24, of the *Mathieu* reference reveal that the damper cap 16 is pivotally attached, as indicated at 17, to the damper housing 14. As stated in W.L. Gore & Associates v. Garlock Inc., 220 USPQ 303, 313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984):

Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration.

Mathieu fails to anticipate Applicants' invention of claim 1 (formerly claim 27) because *Mathieu* does not teach of the

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extension section preventing rotation of the second clamp member about the fastener. Rather, the *Mathieu* damper cap 16 is prevented from rotating about the *Mathieu* hex-headed attachment screw 18 by virtue of its pivotal attachment to the damper housing 14 at 17. Thus, it is actually the pivotal attachment at 17 that prevents rotation of the *Mathieu* damper cap 16 not the short edges of the damper housing 14. As such, the rejection of independent claim 1 (formerly claim 27 in the parent case) under 35 U.S.C. §102(b) was improper.

Nor is it obvious to modify the *Mathieu* vibration damper to produce something that more closely resembles Applicants' invention of independent claim 1. Well-established patent practice dictates that a modification that would render a device unworkable for its intended purposes provides strong evidence supporting a failure to suggest such a modification. As stated in National Tractor Pullers Assn., Inc. v. Watkins, 205 USPQ 892 at 911 (ND ILL, March, 1980):

A modification of a prior art patent or device which would render that device unworkable for its intended purposes cannot be said to suggest such a modification.
(emphasis supplied)

A purpose of the *Mathieu* pivotal attachment at 17 of damper cap 16 to damper housing 14 is to facilitate attachment of the vibration damper to the power transmission cable (col. 3, lines 37-43). *Mathieu* fails to teach or suggest the desirability of modifying the *Mathieu* vibration damper by removing the pivotal attachment at 17 from the *Mathieu* vibration damper because the removal of the pivotal attachment at 17 would make attachment of the *Mathieu* vibration damper more difficult. Attachment of the *Mathieu* vibration damper to the power transmission cable would be

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made significantly more difficult because the short edges of the damper housing 14 do not extend far enough to prevent rotation of the damper cap 16 about attachment screw 18 when enough loosening turns of the attachment screw 18 are made to enable insertion of the cable between the damper housing and damper cap. Thus, a modification of the *Mathieu* vibration damper to eliminate the pivotal attachment at 17 would render *Mathieu* unworkable for its intended purpose of facilitating attachment of the vibration damper to the power transmission cable. Since *Mathieu* would be rendered unworkable for its intended purpose, *Mathieu* cannot suggest the desirability of modifications which make the *Mathieu* vibration damper more closely resemble Applicants' invention of claim 1.

For the reasons set forth above, *Mathieu* fails to teach or suggest Applicants' invention of independent claim 1 (formerly claim 27). Accordingly, independent claim 1 is believed to be allowable. Claims 2-10 depend directly or indirectly from claim 1. Accordingly, claims 2-10 are believed allowable for the reasons set forth above. In addition, claims 2-10 are allowable for independent reasons.

For example, claim 8 (formerly claim 31 in the parent application) includes the limitation of the fastener being an eyebolt. Claim 9 (formerly claim 32 in the parent application) recites further limitations of the eyebolt having a shaft, a threaded portion at a first end of the shaft for interconnection with the first and second clamp members, and a loop portion located at a second end of the shaft for engagement with an installation tool for the vibration damper.

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The Office Action in the parent case acknowledges that *Mathieu* does not disclose that the fastener is an eyebolt. The Office Action then concludes that it would have been obvious to make the fastener an eyebolt, instead of a standard bolt, as taught by *Mathieu*, for the purpose of allowing an attachment point, since it has been held that more than a mere change of form is necessary for patentability.

Applicant believes that a rejection of claims 8 and 9 (formerly claims 31 and 32) in view of *Mathieu* is improper because the features of claims 8 and 9 have been ignored, thus leading to the use of hindsight in making the obviousness rejection. As stated in In re Debus, Civ. App. No. 93-1320, slip op. at 3 (FED. Cir. Dec. 10, 1998) (unpublished):

"The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification ." *In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ 2d 1780, 1783-84 (Fed. Cir. 1992)....

The beveling on applicants' page holder is not merely ornamental; it is there because applicants have found that it makes page turning easier. Thus, this feature of applicants' invention, which is expressed both structurally and functionally in the claim, cannot be ignored. The claimed invention may in hindsight be a simple improvement but the test for obviousness is not the simplicity of the improvement.

Moreover, as stated in In re Spinnoble, 160 USPQ 237, 243 (C.C.P.A. 1969):

It should not be necessary for this court to point out that a patentable invention may lie in the discovery of the source of a problem even though the remedy may be obvious once the source of the problem is identified. This is part of the "subject matter as a whole" which should always be considered in determining the

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obviousness of an invention under 35 U.S.C. 103....The court must be ever alert not to read obviousness into an invention on the basis of the applicant's own statements; that is, we must view the prior art without reading into that art appellant's teachings....The issue, then, is whether the teachings of the prior art would, in and of themselves and without the benefits of appellant's disclosure, make the invention as a whole, obvious.

Accordingly, the proper evaluation for determining patentability is to consider whether the prior art suggests the desirability of modifications which make the prior art device more closely resemble Applicant's invention of claim 1. This suggestion must be found in the prior art and without the benefits of Applicants' disclosure.

As discussed in detail in Applicants' Background of the Invention section of the specification, there are several problems associated with the installation of vibration dampers on existing construction. The installation of vibration dampers on existing construction calls for either taking a planned power outage, or alternatively, working on energized electrical conductors. Power outages, planned or otherwise, are inconvenient at best, and can be dangerous should the power outage disrupt the operation of traffic signals, hospital equipment, and so forth. However, working on energized electrical conductors is hazardous to the service personnel, requires two linemen manipulating two or more hot sticks, and is time consuming. The duration combined with the use of two linemen for each installation undesirably drives up the cost of each installation.

Applicants solve this problem through the use of an eyebolt fastener which enables manipulation of a vibration damper with an installation tool. Consequently, the use of an eyebolt is not a

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mere change of form, but is a patentable improvement that makes it possible for a single lineman to rapidly, and cost effectively, install a vibration damper on a suspended conductor. This feature of Applicants' invention is expressed both structurally and functionally in claims 8 and 9. While this feature of Applicants' invention may appear in hindsight to be a simple improvement, the simplicity of the improvement does not negate invention.

Mathieu suffers from the very problem that Applicants' invention of claims 8 and 9 solves. That is, installation of the *Mathieu* vibration damper onto a suspended conductor with the hex-headed attachment screw 18 requires the costly, and time consuming, services of two linemen. Moreover, *Mathieu* fails to teach or suggest the desirability of an eyebolt for coupling the *Mathieu* damper cap 16 with the damper housing 14 because the *Mathieu* reference is directed toward a different problem. That is, *Mathieu* is concerned with durable and reliable construction, increasing the overall vibration damping efficiency, and the ready and convenient adaptation of the vibration damper to effective vibration damping. Consequently, there is no line of reasoning to suggest why one skilled in the art would be motivated to make the changes required of *Mathieu* to more closely resemble Applicants' claimed invention without first having read Applicants' specification. Rather, it is only Applicants' specification which teaches doing that which Applicants claim.

Hindsight reconstruction based on Applicants' specification is improper and is impermissible under patent law. Consequently, a proper obviousness evaluation indicates that Applicants' invention of claims 8 and 9 is a patentable improvement that is

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neither taught nor suggested by the prior art. Accordingly, claims 8 and 9 are believed allowable.

Independent claim 11 (formerly claim 13 in the parent case) relates to a fastener for securing a second clamp member of a vibration damper to a first clamp member. The fastener includes a shaft, a threaded portion at a first end of the shaft for interconnection with the first and second clamp members, and a loop portion located at a second end of the shaft for engagement with an installation tool for the vibration damper. Thus, claim 11 is allowable for the reasons set forth above in connection with claims 8 and 9.

Independent claim 12 (claim 1 in the parent case) includes limitations directed toward the first clamp member having a first extension section and a second extension section, and the first and second extension sections continuously abutting the second clamp member to prevent rotation of the second clamp member about the fastener.

As discussed above in connection with claim 1, *Mathieu* does not teach of extension sections preventing rotation of the second clamp member about the fastener. Rather, the *Mathieu* damper cap 16 is prevented from rotating about the *Mathieu* hex-headed attachment screw 18 by virtue of its pivotal attachment to the damper housing 14 at 17. Thus, it is actually the pivotal attachment at 17 that prevents rotation of the *Mathieu* damper cap 16 not the short edges of the damper housing 14.

As such, the rejection of independent claim 12 (formerly claim 1 in the parent case) under 35 U.S.C. §102(b) was improper, and claim 12 is believed allowable for the reasons set forth in

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connection with claim 1. Claims 13-19 depend directly or indirectly from claim 12. Consequently, claims 13-19 are also believed allowable. In addition, claims 17 and 18 (formerly 5 and 6 in the parent case) are allowable for the reasons set forth in connection with claims 8 and 9.

Accordingly, claims 1-6, 13, and 27-32 from the parent application have been renumbered and amended in the accompanying 37 CFR 1.53(b) Continuation application. In addition, new claims 3, 5, 7, 10, 16, and 19 have been added in this Continuation application.

Applicant believes that the foregoing amendments and remarks are fully responsive to the rejections recited in the 30 July 2003 Office Action in the parent case (10/093,243) and that the present 37 CFR 1.53(b) Continuation application is in a condition for allowance. Consideration of the accompanying 37 CFR 1.53(b) Continuation application is respectfully requested.

Respectfully submitted,

A handwritten signature in dark ink, appearing to read 'Lowell W. Gresham', is written over a horizontal line.

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